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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,987	03/24/2005	Peter Stierle	3169	6380
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743			EXAMINER JOYCE, WILLIAM C	
			ART UNIT 3656	PAPER NUMBER
			MAIL DATE 02/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,987

Applicant(s)

STIERLE ET AL.

Examiner

William C. Joyce

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 and 6-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 1, 6-11 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to the RCE filed January 22, 2009 for the above identified patent application.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "hand power tool" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 6-11, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over German reference 39 22 552 (DE '552) in view of US Patent 2,961,856 (US '856).

DE '552 teaches a gear mechanism having a driving gear wheel (10), seated in a manner fixed against relative rotation on a drive shaft, and a driven gear wheel (12), meshing with the driving gear wheel and driving a driven shaft, wherein a spring- elastic damping element (13) are located between the driven gear wheel and the driven shaft.

DE '552 does not teach a plurality of dampening elements disposed between the driven gear and the driven shaft. The prior art to US '856 teaches a plurality of spring- elastic damping elements (32) located between the driven gear wheel (18) and the driven shaft (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the dampening

arrangement of DE '552 with the dampening device having a plurality of dampening elements, as taught by US '856, motivation being to provide a gear that reduces shock, strain, and torsional vibrations.

With respect to claim 6, DE '552 shows the ring of the slaving device being pressed onto the shaft.

Alternatively, US '856 illustrates the slaving device being formed integrally with the shaft, but forming the slaving device and shaft as separate components that are joined with a pressed connection is not considered inventive. Official Notice is taken with respect to forming two components as separate members that are joined with a pressed connection is considered old and well known in the art.

With respect to claims 7 and 13, DE '552 illustrates the slaving device being connected to the driven shaft. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the connection between the slaving device and the shaft of DE '552 with a formed connection, such as a spline connection, keyed connection, of a pressed connection, since such connections was notoriously known in the art.

With respect to claims 10 and 14, DE '552 teaches a ring gear driven by a conical pinion.

With respect to claim 16, US '856 teaches the dampening elements having a roller shape that extends parallel to the shaft.

4. Claims 1, 6-11, 13-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over German reference 39 22 552 (DE '552) in view of US Patent 1,425,616 (US '616).

DE '552 teaches a gear mechanism having a driving gear wheel (10), seated in a manner fixed against relative rotation on a drive shaft, and a driven gear wheel (12), meshing with the driving gear wheel and driving a driven shaft, wherein a spring- elastic damping element (13) are located between the driven gear wheel and the driven shaft.

DE '552 does not teach a plurality of spherically shaped dampening elements disposed between the driven gear and the driven shaft. The prior art to US '616 teaches a plurality of spherically shaped damping elements (9) located between the drive member and a driven member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dampening arrangement of DE '552 with a plurality of spherically shaped dampening elements engaging corresponding surfaces, as taught by US '616, motivation being to provide a gear that reduces shock, strain, and torsional vibrations.

With respect to claim 6, DE '552 shows the ring of the slaving device being pressed onto the shaft.

With respect to claims 7 and 13, DE '552 illustrates the slaving device being connected to the driven shaft. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the connection between the slaving device and the shaft of DE '552 with a formed connection, such as a spline connection, keyed connection, of a pressed connection, since such connections was notoriously known in the art.

With respect to claims 10 and 14, DE '552 teaches a ring gear driven by a conical pinion.

With respect to claim 17, US '616 illustrates in Figure 2 the outer surface of the ribs (for example, see the bottom rib) having a rectangular shape.

Response to Arguments

Applicant's arguments filed January 23, 2009 have been fully considered but they are not persuasive.

It is acknowledged the DE '552 does not show a dampening arrangement as defined by the claims. For example, pages 17-18 of applicant's remarks point out a number of the claim features not shown by DE '552. However, the prior art to US '856 teaches a dampening device having the claimed features.

Applicant argues it would not have been obvious to one in the art to combine the teachings of DE '552 and US '856 because the US '856 reference deals with motor trucks and not hand tools. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one in the transmission art would recognize the benefits of using the dampening arrangement of US '856 in the power tool of DE '552, such as to facilitate in the assembly, disassembly, and repair of the device (column 1, lines 47-49).

Further, with respect to the argument of combining the hand tool with the dampening device used in a motor vehicle, US '856 discloses "[T]he foregoing and other important objects and desirable features inherent in and encompassed by the invention together with many of the purposes and uses thereof will become readily apparent from a reading of the ensuing description in conjunction with the annexed drawings" (column 1, lines 65-70).

Applicant argues "the damping device (32) disclosed in U.S. '856 reference, which because of the tooth coupling (24, 20) can dampen only a small circumferential angle, is unsuitable to be transferred to the hand power tool of DE '552 reference" (page 20 of the arguments). It is noted applicant's claims do not define the amount of dampening and therefore the argument is not commensurate with the scope of the claims. Further, the US '856 reference does not specifically disclose the dampening device as being only capable of dampening a small circumferential angle. Accordingly, these arguments are not persuasive.

Accordingly, claims stand rejected as described above.

Allowable Subject Matter

5. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 12, 18, 19 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Joyce whose telephone number is (571) 272-7107. The examiner can normally be reached on Monday - Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William C. Joyce/
Primary Examiner, Art Unit 3656
2/15/09